

REMARKS

In the present amendment, claims 3, 4, 19, 29, and 30 have been amended. Of the pending claims, claims 1-17 and 28-39 are under consideration, and claims 18-27 are withdrawn from consideration.

Applicants note that the claims have been amended to recite a chromium content of 4.0 to 6.2 % by weight. Support for the claim amendments appear throughout Applicants' originally filed application.

Affirmation of Election with Traverse

The Office Action requires an affirmation of the provisional election with traverse, which was made during a telephone conversation between the Examiner and Mr. Stephen Roylance on February 20, 2007.

The Office restricts examination to one of the following inventions under 35 U.S.C. § 121:

- I. Claims 1-17 and 28-39, drawn to a cold work steel article, classified in class 75, subclass 246.
- II. Claims 18-27, drawn to a process for producing a cold work steel article, classified in class 419, subclass 28.

Applicants hereby affirm the election of Group I, claims 1-17 and 28-39, with traverse.

Applicants respectfully submit that a restriction requirement is inappropriate in this case. Even if one were to assume, *arguendo*, that the inventions of Groups I to II are

distinct, the requirement for restriction should be withdrawn because there is no serious burden.

In MPEP Chapter 800, the Office sets forth its policy by which examiners are guided in requiring restriction under 35 U.S.C. § 121. Section 803 states that “[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.”

Applicants note that the inventions of both groups identified in the Restriction Requirement relate to a specific composition of a cold work steel article. Accordingly, as a practical matter, the searches for inventions I and II should significantly overlap. For example, a search for the invention of Group I should cover many of the areas that are also relevant for the inventions of Groups II. Thus, the search burden should not be serious.

For the above reasons alone, the Restriction Requirement should be withdrawn, which action is respectfully requested.

The Examiner is reminded of the rejoinder practice set forth in MPEP § 821.04, i.e., if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend or otherwise include all of the limitations of the allowable product claim will be rejoined.

Response to Claim Objections

The Office Action objects to claims 3 and 4 because the objected claims have a broader chromium concentration range in view of the chromium concentration range of independent claim 1.

Applicants note that claims 3 and 4 have been amended to correct these informalities by reciting a chromium content from more than about 4.0 to less than about 6.2 % by weight, as also claimed in independent claim 1.

Response to Rejection under 35 U.S.C. § 103(a)

The Office Action rejects claims 1-17 and 28-39 under 35 U.S.C. § 103(a) as allegedly unpatentable over JP 2003-055747, hereafter “JP’747”. The Office asserts that the presently claimed composition ranges overlap with the ranges of the elements in the sintered tool steel of JP’747, and concludes it would be obvious for one of ordinary skill to make the presently claimed invention guided by the disclosure of JP’747.

Applicants respectfully traverse this rejection. JP’747 teaches a different steel composition than the present invention, and all of the ranges do not overlap. For example, JP’747 requires a specific ratio of molybdenum to tungsten contributing 15 to 30 weight percent of the steel composition: $(2\text{Mo} + \text{W}) = 15\%-30\%$. This requirement is also reflected in all six examples of JP’747. In contrast, the presently claims recite Mo contents of not more than 3.8% by weight and W contents of not more than 3.4% by weight, resulting in values for $(2\text{Mo} + \text{W}) = 11\%$ (based on the highest ranges for those values). As 11% is not within the range of values of 15-30%, the ranges do not overlap, and a *prima facie* case of obviousness fails for at least this reason.

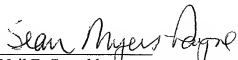
Applicants additionally note that Mo and W are strong carbide-forming agents. Therefore, materials with high Mo and W content typically contain larger amounts of carbide than materials with lower Mo and W content. Accordingly, the properties of the materials disclosed in JP'747 would be completely different than the properties of the materials of the present invention.

In view of the foregoing remarks, Applicants respectfully request withdrawal of the obviousness rejection of claims 1-17 and 28-39 over JP'747.

CONCLUSION

In view of the foregoing, it is believed that all claims in this application are in condition of allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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